force between the sheets of the film of 50 grams or less (paragraph [0022]). The attractive force between the sheets is accordingly reduced, which simplified handling of the sheets during feeding and removal from offset presses.

Claims 1, 3-8 and 10-11 were rejected under 35 U.S.C. § 102 or under 35 U.S.C. § 103 as being anticipated or rendered obvious by PCT '601 as represented by Nishizawa et al. The Examiner there took the position that Nishizawa et al teaches a stretched film of a void-containing thermoplastic resin made of a material and having a void content similar to that claimed in the present application. Since "like material has like property," Nishizawa et al "anticipates or strongly suggests the claimed subject matter."

This rejection is respectfully traversed. Nishizawa et al does not teach or suggest a stretched film of a void containing thermoplastic resin has a surface charge potential, after discharging of the film, of -10 to 10 kV. The Office Action relies on this surface charge potential being inherently present in Nishizawa et al due to the similarity of the material and void content in Nishizawa et al ("like material has like property"). However it is respectfully submitted that such an "inherency" rejection is misplaced. Inherency requires that the allegedly inherent feature must necessarily be present in the prior art. MPEP § 2112. In fact, not only is the claimed surface charge potential not "necessarily present," in Nishizawa et al but **the specification provides evidence that it *cannot* be present**.

The film in Nishizawa et al is not inherently a "like material" to that of the claims because it has not been subject to a direct current voltage overlaid on a high voltage of high frequency as is presently disclosed. Indeed, **a charge potential of from -10 to 10 kV cannot be achieved without providing a direct current voltage overlaid on a high voltage of high frequency**. For example, the Comparative Examples 1 and 2 described in paragraphs [0067]-[0069] of the present application lacked a step of superimposing a direct current voltage on the high voltage and high frequency discharge, and respectively produced residual

surface charges of 40 kV or 30 kV. On the other hand, the stretched films according to the inventive examples 1-6 were produced by providing a charge discharging step wherein a direct current voltage was overlaid on a high voltage of high frequency, and had a residual surface charge in the claimed range. The feeding performance of the sheets was then tested using an offset press (paragraph [00104]). As a result, it was confirmed (paragraphs [00109]-[00111]) that in the stretched films according to inventive Examples 1-6, the attractive force between sheets was small, and the feeding of the sheets on offset presses was excellent. Additionally, the stretched films of Examples 1-6, which had a heat seal property on the C layer, was confirmed to be suitably applicable to use in various types of heat sealing such as in-mold labeling or header labeling. On the other hand, the stretched films of the comparative examples adhered tightly to each other due to static electricity and were extremely inferior in feeding and emission from offset presses.

Thus the present specification provides evidence that a similar composition and void ratio is insufficient to inherently provide the claimed charge potential, without additionally providing a direct current voltage overlaid on a high voltage of high frequency, since Example 1 and comparative Example 1 are *identical* (paragraph [0067]) except for providing a direct current voltage overlaid on a high voltage of high frequency. Thus Nishizawa et al does not anticipate the claims.

Nor would the claimed thermoplastic resin having a surface charge potential, after discharging of the film, of -10 to 10 kV be obvious from Nishizawa et al. There is no description in Nishizawa et al of a desire to limit the surface charge potential and so no motivation in the art for providing the claimed surface charge potential. Additionally, any *prima facie* case of obviousness is rebutted by the showing of criticality in the Examples including Comparative Examples 1 and 2. M.P.E.P. § 2144.05(III).

Claims 1 and 3-11 were also rejected under 35 U.S.C. § 103 as being obvious over Lin. However, the above remarks also apply to this reference. Lin is directed to a process of forming three layer coextruded biaxial oriented polypropylene synthetic paper, in which the synthetic paper is subjected to a corona discharge to improve the printability of the surface of the film. Again, however, there is no disclosure in the reference of applying a direct current voltage overlaid on a high voltage of high frequency in order to dissipate the resulting surface charge, and so the presently claimed surface charge is not inherent therein. This, combined with the evidence of criticality results set forth in the specification, clearly points to the unobviousness of the claims over Lin.

Claims 1, 3-8 and 10-11 were also rejected under 35 U.S.C. § 103 as being obvious over EP '544. However, here again, there is no teaching of applying a direct current voltage overlaid on a high voltage of high frequency in order to dissipate the resulting surface charge, and so the presently claimed surface charge is not inherent therein. This, combined with the evidence of criticality results set forth in the specification, clearly points to the unobviousness of the claims over this reference.

Concerning paragraphs 9-10 of the Office Action, the further reference to Burns et al was cited to teach a feature of several of the dependent claims, and provides no teaching for overcoming the shortcomings of the primary references with respect to amended Claim 1. Applicants therefore respectfully submit that the amended claims define over any combination of the above references.

Applicants believe that the present application is in a condition for allowance and respectfully solicit an early Notice of Allowability.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
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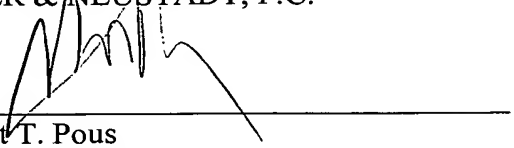

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